

Attorney's Docket No. JM 7189
Application No. 09/996,454
Page 7

REMARKS

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Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111, and in light of the remarks which follow, are respectfully requested.

Claims 18 and 24 have been amended to provide proper antecedent basis. New claim 25 finds support on page 12, lines 3-4, of the specification while new claim 26 finds support on page 11, Table 3. The Disposition of Claims in box No. 4 in the Office Action Summary attached to the Office Action mailed June 22, 2006 is believed to be incorrect. Claims 4 and 21-23 were canceled in the Amendment filed February 14, 2006. Accordingly, claims 1- 3, 5-20 and 24-26 are currently pending in this application.

Claims 1-3, 5-20 and 24 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,291,011 (Edlund) in view of U.S. Patent No. 4,902,722 (Melber) for the reasons set forth in paragraph (3) of the Office Action. Claims 1-3, 5-20 and 24 were rejected under 35 U.S.C. §103(a) as obvious over Edlund '011 in view of U.S. Patent No. 4,433,022 (Schwartz et al) for the reasons set forth in paragraph (4) of the Official Action. Withdrawal of these rejections is requested in view of the above amendments and the following remarks.

The process of the present invention produces a decorative wallcovering having a first hydrophobic layer applied to selective portions of the impregnated fabric in the form of a decorative pattern and a second layer applied to selective portions of the fabric in the form of a foamed three-dimensional image pattern. The product is designed to be applied to a wall and may subsequently be painted to create colorful three-dimensional designs of an infinite variety.

Attorney's Docket No. JM 7189
Application No. 09/996,454
Page 8

The process of Edlund '011 involves the initial application of a hydrophilic layer over the entire surface of a glass fiber fabric followed by the application of a hydrophobic layer in a decorative pattern on selected portions of the hydrophilic layer. After application to a wall surface, the conditioned, partially decorated wallcovering is painted. Since the surface of the wallcovering has discontinuous hydrophobic and hydrophilic areas, the finished painted product exhibits distinctive decorative images as exemplified in Figure 3 of Edlund '011. Accordingly, it is an important feature of Edlund '011 that the process described therein produces a "conditioned" intermediate product having a significant area with hydrophilic properties as well as patterned hydrophobic areas. When subsequently painted, the resultant product is a finished wallcovering with distinctive contrasting patterns as a result of applying the paint to hydrophilic and hydrophobic areas.

Edlund '011 does not disclose the presently claimed step of providing a three-dimensional decorative foamed pattern by heating a mixture of expandable chemicals. The Office Action alleges that it would have been obvious to so modify the process of Edlund '011 in view of Melber '722 or Schwartz et al '022. Respectfully, Applicants disagree.

Melber '722 and Schwartz et al '022 both disclose the application of an expandable coating to a fibrous substrate followed by heating to produce a three-dimensional foamed decorative layer on the substrate. Neither reference discloses applying the expandable coating to an already-decorated substrate.

According to the Office Action, it would have been obvious to use the image coating step of Melber '722 or Schwartz et al '022 in the process of Edlund '011. However, applying the expandable coating of Melber '722 or Schwartz et al '022 to the partially decorated, "conditioned" wallcovering of Edlund '011 would cover the hydrophilic areas which would

Attorney's Docket No. JM 7189
Application No. 09/996,454
Page 9

be unavailable for subsequent painting and would be contrary to the objectives of Edlund '011.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The motivation to modify the relied on prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. *In re Napier*, 55 F.2d 610, 613; 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995). Obviousness cannot be established by modifying the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the modification. *In re Geiger*, 815 F.2d 686, 688; U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987).

Applicants submit that there is no disclosure in the cited art which would have motivated those of ordinary skill in the art to modify the process of Edlund '011 to include the step of Melber '722 or Schwartz et al '022. Nor could one have reasonably expected that such a modification would have been successful, bearing in mind that applying an expandable coating to the partially imaged fabric of Edlund '011 would undoubtedly cover the hydrophilic areas which are designed to be painted by the consumer to effect a final decorative effect.

The teachings of Melber '722 and Schwartz et al '022 may establish that expandable coatings to provide three-dimensional decorative effects were known in the art. They provide no suggestion, however, to add a step of using an expandable coating to the process of

Attorney's Docket No. JM 7189
Application No. 09/996,454
Page 10

Edlund '011. As stated in In re Kotzab, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316-17

(Fed. Cir. 2000):

[m]ost if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant [citations omitted].

In the Office Action, it is argued that although the material of Edlund is to be finally painted, "This would not preclude one of ordinary skill in the art from providing the foamable coating in order to impart additional design to the material." (page 4, paragraph 5, third sentence). The issue is not whether one skilled in art would be precluded from adding a foamable coating but, rather, whether the cited art in combination contains a suggestion to do so.

Claims I and 24 specify that the second image coating is "applied from a chemical mixture consisting essentially of a polymeric binder and expandable chemicals" (claim 1) or "consisting essentially of a polymeric binder and expandable microspheres" (claim 24). The expandable compositions disclosed in Melber '722 are set forth in Examples II, III and IV. These contain expandable microspheres, pre-expanded microspheres, water and an unspecified vehicle. No polymeric binders are present in these expandable formulations, let alone in the amount set forth in present claim 25.

For at least the aforementioned reasons, the §103(a) rejection based on Edlund '011 in view of Melber '722 or Schwartz et al '022 should be withdrawn. Such action is earnestly requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any

Attorney's Docket No. JM 7189
Application No. 09/996,454
Page 11

questions concerning this paper or the application in general, the Examiner is invited to
telephone the undersigned.

Respectfully submitted,

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Sept 15, 2006

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